

REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated December 24, 2008 ("*Office Action*"). At the time of the *Office Action*, Claims 1-32 were pending and rejected. Applicants have amended Claims 1 and 14-32. Applicants submit that no new matter has been added by these amendments. As described below, Applicants believe all claims to be allowable over the cited references. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

Section 101 Rejections

The Examiner rejects Claims 14-27 and 28-32 under 35 U.S.C. § 101 because the claimed invention is "directed towards computer programs representing computer listings per se." (*Office Action*, page 2).

Although Applicants believe that the claims as originally submitted do in fact recite statutory subject matter, in order to advance prosecution of this Application, Applicants have amended Claims 14-27 to recite "software" embodied in a "memory" and comprising "programming operable when executed by a computer" to perform the recited functions. Under M.P.E.P. § 2106.01(I), "[a] claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the medium which permit the data structure's functionality to be realized, as thus is statutory." Moreover, the Federal Circuit even more recently stated that "we decline to adopt a broad exclusion over software or any other such category of subject matter beyond the exclusion of claims drawn to fundamental principles set forth by the Supreme Court." *Bilski*, 2008 WL 4757110 at *11 n.23. These unequivocal statements by the Federal Circuit clearly condone claims directed to software. Therefore, Applicants submit that Claims 14-27 recite patentable subject matter. Thus, Applicants respectfully request that the rejections of Claims 14-27 under 35 U.S.C. § 101 be withdrawn.

Section 103 Rejections

The Examiner rejects Claims 28-29 and 31-32 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,536,659 issued to Hauser et al. ("*Hauser*") *Hauser* in

view of U.S. Patent Application Publication No. 2002/0077976 issued to Meyer et al. (“*Meyer*”).

Independent Claim 28 of the present Application, as amended, recites:

Software for providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, the software embodied in a memory and comprising programming operable when executed by a computer to:

access item data representing at least one detail about the item;

access transaction data representing at least one detail about the transaction associated with the item;

correlate the item data and transaction data with a set of stored business rules to determine coding to be printed on a shipping label; wherein the set of stored business rules specify how packages are to be shipped from the customer to the returns center and represent guidelines for determining a selected shipping carrier, a shipping destination, and a shipping class or rate for shipment from the customer to the returns center;

in response to correlating the item data and transaction data with the set of stored business rules specifying how packages are to be shipped, generate a machine readable code for the return shipping label for shipment from the customer to the returns center, wherein the data represents the results of the correlating step and represents at least a shipping origin of the package and identification of the transaction; and

in response to correlating the item data and transaction data with the set of stored business rules specifying how packages are to be shipped from the customer to the returns center, format the return shipping label, such that the return shipping label contains the machine readable code and complies with shipping label specifications of the selected shipping carrier.

Whether considered alone or in combination, *Hauser* and *Meyer* do not disclose, either expressly or inherently, each and every element of the claims.

For example, the proposed *Hauser-Meyer* combination does not disclose, teach, or suggest programming operable to “correlate the item data and transaction data with a set of stored business rules **to determine coding to be printed on a shipping label**; wherein the set of stored business rules specify **how packages are to be shipped from the customer to the returns center** and represent guidelines for determining a selected shipping carrier, a shipping destination, and a shipping class or rate for shipment from the customer to the returns center,” as recited in Applicants’ Claim 28. In the *Office Action*, the Examiner relies upon *Hauser* for disclosure of Applicants’ correlating step and Applicant’ “set of stored

business rules specify[ing] how packages are to be shipped . . .” (*Office Action*, page 4). However, *Hauser* merely discloses that customers “are provided with a return authorization shipping label by the returns facility.” (*Hauser*, Abstract).

Specifically, *Hauser* discloses that “[u]pon receiving the data from a merchant who has authorized the return of merchandise, Returns Online, Inc. will generate a return authorization shipping label.” (*Hauser*, Column 4, lines 16-19). The return shipping label “may include either a prepaid United States Postal Service Postage Permit or other private shipper forms.” (*Hauser*, Column 4, lines 26-30). The return shipping label “includes the address for Returns Online, Inc., and a bar code that is scannable for identifying the merchant and merchandise being returned.” (*Hauser*, Column 6, lines 21-27). Thus, while the shipping label includes a barcode identifying the particular merchant and particular merchandise and is used to ship the item to the central return facility, there is no disclosure in *Hauser* of using a set of rules relating to how packages are to be shipped or that guidelines for selecting a shipping carrier, a shipping destination, and a shipping class or rate are used to determine the coding for the barcode on the shipping label. Accordingly, *Hauser* does not disclose, however, programming operable to “correlate the item data and transaction data with a set of stored business rules **to determine coding to be printed on a shipping label**; wherein the set of stored business rules specify **how packages are to be shipped from the customer to the returns center and represent guidelines for determining a selected shipping carrier, a shipping destination, and a shipping class or rate for shipment from the customer to the returns center**,” as recited in Applicants’ Claim 28.

Applicants once again note that the *Office Action* points to column 6, lines 50-65 for disclosure of Applicants’ correlating step. However, the cited portion of *Hauser* merely discloses that a “bar code tag 71 indicating the disposition is applied to the returned merchandise or to container 60” and that “container 60 and/or returned merchandise 62 is directed onto an automated conveyor system 70.” (*Hauser*, Column 6, lines 50-53). However, bar code tag 71 relates to a tag that is applied at a processing station at the returns center only after the processing and inspection of the container. (*Hauser*, Column 6, lines 43-49; see also, Figure 1, reference numerals 26-32; Figure 2, reference numeral 62). Thereafter, “the disposition indicated on bar code tag 71 is scanned using a scanner 64c,” and the conveyor system “direct[s] the returned merchandise to an appropriate temporary storage bin.” (*Hauser*, Column 6, lines 56-60). Thus, bar code 71 is merely placed on the returned

item after the item is shipped to the returns center and after an inspection is performed at the returns center. Bar code 71 is not at all associated with a return shipping label and does not at all relate to the shipping of the item. Thus, to the extent that *Hauser* discloses correlating data with business rules, such correlating and such business rules are not related to the generation of a shipping label. For at least these reasons, *Hauser* does not disclose programming operable to “correlate the item data and transaction data with a set of stored business rules **to determine coding to be printed on a shipping label**; wherein the set of stored business rules specify **how packages are to be shipped from the customer to the returns center and represent guidelines for determining a selected shipping carrier, a shipping destination, and a shipping class or rate for shipment from the customer to the returns center**,” as recited in Applicants’ Claim 28.

In the *Office Action*, the Examiner acknowledges that *Hauser* does not disclose that the machine readable code is generated/correlated from the item data, transaction data, customer data, package data with a set of stored business rules. (*Office Action*, page 4). Instead, the Examiner relies upon *Meyer* for disclosure the generation of the machine readable code from the data. As acknowledged by the Examiner, however, *Meyer* merely discloses generation of a code “for the benefit of permitting a 3rd party to scan the bar code and based on the identifying data of the bar code, to effect a specific task automatically or more efficiently or in a pre-determined manner for a certain party/entity involved in the transaction or service, i.e. to effect a payment to the biller in a predetermined amount {see abstract; pars. 0030-0031; 0051; figures 1, 6-8}.” (*Office Action*, page 4).

More specifically, *Meyer* discloses “a bill payment system” for generating “at least one invoice for at least one customer.” (*Meyer*, Page 4, paragraph 30). According to *Meyer*, the invoice includes “a unique bar code comprising data identifying at least the customer and the biller.” (*Meyer*, Page 4, paragraph 30). Thus, like *Hauser*, the bar code merely identifies the customer and the merchant. Contrary to the assertion of the *Office Action*, *Meyer* does not disclose the generation of the bar code based on business rules. Certainly, *Meyer* does not disclose the correlation of the business rules to generate the coding based on business rules **specifying how packages are to be shipped** or guidelines determining **a selected shipping carrier, destination, and shipping class** for the shipping label since *Meyer* does not relate to the shipment of packages. In fact, aside from disclosing that the invoice is mailed to the customer so that the customer can pay the bill (*Meyer*, Pages 4-5, paragraph

51), the barcode on the invoice is not at all related to the shipping of an item. Thus, *Meyer* does not cure the deficiencies of *Hauser*.

Neither reference nor their proposed combination discloses, teaches, or suggests programming operable to “correlate the item data and transaction data with a set of stored business rules **to determine coding to be printed on a shipping label**; wherein the set of stored business rules specify **how packages are to be shipped from the customer to the returns center** and represent guidelines for determining a selected shipping carrier, a shipping destination, and a shipping class or rate **for shipment from the customer to the returns center**,” as recited in Applicants’ Claim 28.

As further examples of the deficiencies of the proposed *Hauser-Meyer* combination, Applicants submit that neither reference nor their proposed combination discloses, teaches, or suggests programming operable to “in response to correlating the item data and transaction data with the set of stored business rules specifying how packages are to be shipped, generate a machine readable code for the return shipping label for shipment from the customer to the returns center, wherein the data represents the results of the correlating step and represents at least a shipping origin of the package and identification of the transaction” and “in response to correlating the item data and transaction data with the set of stored business rules specifying how packages are to be shipped from the customer to the returns center, format the return shipping label, such that the return shipping label contains the machine readable code and complies with shipping label specifications of the selected shipping carrier,” as recited in Applicants’ Claim 28. As stated above, *Hauser* merely discloses that Returns Online, Inc. will generate a prepaid United States Postal Service Postage Permit or other private shipper forms that “includes the address for Returns Online, Inc., and a bar code that is scannable for identifying the merchant and merchandise being returned.” (*Hauser*, Column 4, lines 16-19; Column 4, lines 26-30; Column 6, lines 21-27). *Meyer* discloses an invoice that includes “a unique bar code comprising data identifying at least the customer and the biller.” (*Meyer*, Page 4, paragraph 30). Thus, at most *Hauser* and *Meyer* may be combined to disclose that a bar code label on a shipping label may identify the merchant, merchandise, and customer. For reasons similar to those discussed above, neither reference discloses correlating business rules relating to shipping to generate a bar code. Accordingly, neither reference nor their proposed combination discloses, teaches, or suggests programming operable to “in response to correlating the item data and transaction data with the set of stored business rules

specifying how packages are to be shipped, generate a machine readable code for the return shipping label for shipment from the customer to the returns center, wherein the data represents the results of the correlating step and represents at least a shipping origin of the package and identification of the transaction” and “in response to correlating the item data and transaction data with the set of stored business rules specifying how packages are to be shipped from the customer to the returns center, format the return shipping label, such that the return shipping label contains the machine readable code and complies with shipping label specifications of the selected shipping carrier,” as recited in Applicants’ Claim 28.

For at least these reasons, Applicants request reconsideration and allowance of independent Claim 28, together with Claims 29 and 31-32 that depend on Claim 28.

The Examiner rejects Claims 1-27 and 30 under 35 U.S.C. 103(a) as being unpatentable over *Hauser* in view of U.S. Patent Application Publication No. 2004/0128265 issued to Holtz et al. (“*Holtz*”) and further in view of *Meyer*.

Independent Claim 1 of the present Application, as amended, recites:

A computer-implemented method of providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising the steps of:

- accessing item data representing at least one detail about the item;
- accessing transaction data representing at least one detail about the transaction associated with the item;

- accessing customer data representing at least one detail about a customer associated with the transaction;

- accessing package data representing at least one detail about the package in which the item is expected to be shipped;

- correlating the item data, transaction data, customer data, and package data, with a set of stored business rules to determine coding to be printed on a return shipping label; wherein the set of stored business rules specify how packages are to be shipped from the customer to a returns center and represent guidelines for determining choice of carrier, shipping destination, shipping rate, and package disposition for shipment from the customer to the returns center;

- in response to correlating the item data, transaction data, customer data, and package data with the set of stored business rules specifying how packages are to be shipped, generating a machine readable code for the return shipping label for shipment from the customer to the returns center, wherein the data represents the results of the correlating step and

represents at least a shipping origin of the package and identification of the transaction; and

in response to correlating the item data, transaction data, customer data, and package data with the set of stored business rules specifying how packages are to be shipped from the customer to the returns center, formatting the return shipping label, such that the return shipping label contains the machine readable code and complies with shipping label specifications of the choice of carrier.

Thus, Claim 1 recites certain claim elements that are similar to those discussed above with regard to Claim 28. The *Office Action* relies upon *Hauser* and *Meyer*, specifically, for disclosure of the Applicants' steps of "correlating," "generating," and "formatting." (*Office Action*, pages 5-6). However, Applicants have shown above with regard to Claim 28 that *Hauser* and *Meyer* do not disclose the recited claim elements. Because *Holtz* does not relate to the correlating of business rules for the generation of a shipping label and does not cure the deficiencies discussed above, Applicants respectfully submit that Claim 1 is allowable over the proposed *Hauser-Holtz-Meyer* combination.

As a further example of the deficiencies of the cited references, Applicants respectfully submit that the proposed *Hauser-Holtz-Meyer* combination does not disclose, teach, or suggest "accessing package data representing at least one detail about the package in which the item is **expected to be shipped**," as recited in Claim 1. The *Office Action* acknowledges that the recited claim elements are not disclosed in *Hauser* and continues to rely upon *Holtz*. (*Office Action*, page 8). However, *Holtz* relates to the processing of return merchandise postal workers **after** such items are received at the mail center. Specifically, *Holtz* states that "the mail delivery process begins when one or more delivery trucks deposit unsorted or "raw" mail, which includes various types of envelopes, packages, or other articles for delivery to different destinations, upon a processing site." (*Holtz*, Page 1, paragraph 9). According to *Holtz*, workers "calculate the postage due for each package based on, among other things, the weight, the origin, and the destination of the package, for example." (*Holtz*, Page 2, paragraph 13). Thus, postal workers at the post office "must perform the time consuming processing steps" related to the delivery of postage manifests "during the night before delivery, or during the early hours of the day before packages can be delivered." (*Holtz*, Page 2, paragraph 14). To aid in the preparation of these manifests, *Holtz* discloses "a processing workstation" in the postal center that is "configured to allow an operator to perform postage due calculations remote from the processing path based upon the package

image and the weight information in the database network.” (*Holtz*, Page 2, paragraph 16). Thus, *Holtz* does not at all relate to the generation of a return shipping label. At most the proposed combination of references discloses weighing at an intermediary point in shipping to calculate the postage due. Because neither of *Hauser* nor *Holtz* disclose “accessing package data representing at least one detail about the package in which the item is **expected** to be shipped,” Applicants’ Claim 1 is allowable over the proposed combination of references.

For at least these reasons, Applicants request reconsideration and allowance of independent Claim, together with Claims 2-13 that depend on Claim 1. For analogous reasons, Applicants also request reconsideration and allowance of independent Claim 14, together with Claims 15-27 that depend on Claim 14.

Claim 30 depends upon independent Claim 28, which Applicants have shown above to be allowable. Thus, Claim 30 is not obvious over the cited references at least because Claim 30 include the limitations of Claim 28.

Additionally, Claim 30 recites claim elements that further distinguish the art. For example, dependent Claim 30 recites that the “programming is further operable to access package data representing at least one detail about the package in which the item is expected to be shipped, and to further correlate package data with the business rules.” In the *Office Action*, the Examiner again relies upon *Holtz* as disclosing the recited claim elements. (*Office Action*, page 12). However, Applicants have shown above that the similar claim elements recited in Claim 1 are not disclosed, taught, or suggested by the prior art of record. Accordingly, for reasons similar to those discussed above, Applicants respectfully submit that Claim 30 is patentable over the cited references..

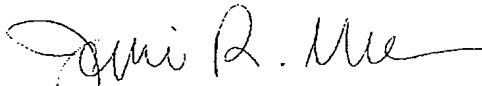
CONCLUSION

Applicants have made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicants, at the Examiner's convenience at (214) 415-4820.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credits to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants


Jenni R. Moen
Reg. No. 52,038

Date: February 24, 2009

Correspondence Address:

at Customer Number: **05073**